## REMARKS

Claims 77 to 106 are pending in this application, and have been rejected by the Examiner.

35 U.S.C. § 103

The Examiner rejected claims 77-106 "under 35 U.S.C. § 103(a) as being unpatentable over Gordon et al. (U.S. Patent No. 5,932,612) in view of [Clum et al. (U.S. Patent No.5,559,149)][1]." Applicant traverses this rejection for at least the following reasons.

According to the Examiner, Gordon is silent as to the specific pH of the composition, and "Gordon does not specifically teach adding an [sic] protected retinoid." However, the Examiner asserts that "pH is an inherent characteristic and is encompassed therein." Additionally, the Examiner attempts to utilize Clum for a teaching of "stable skin care compositions comprising a water-in oil emulsion base containing retinoids[.]"

A rejection under 35 U.S.C. 103 must include the teachings of all of the claimed elements, and also a teaching or suggestion to modify or combine the cited references to render the claimed invention obvious. While Applicant agrees with the Examiner that pH is an inherent characteristic of any composition, Applicant notes that the claimed invention requires a specific pH of about 5.5 to about 8.0. Applicant's invention has the unexpected result of being stable at the claimed pH range. Nothing in Gordon teaches that Gordon's composition would inherently have the claimed pH. Therefore, Gordon cannot be said to teach the claimed pH, which as is noted in Applicant's specification in paragraph 8, is a surprising characteristic of a composition containing hydroquinone and cationic salts of acidic ascorbyl esters.

[1] The Examiner did not complete this sentence, but Applicant believes that Clum was meant by the Examiner. If that is not correct, Applicant requests the courtesy of a phonecall to address this issue.



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Hydroquinone in the prior art discolors at the pH range of 7.0 to 8.5, and the recommended pH in the prior art for cationic of acidic ascorbyl esters is about 7.0 to 8.5. Therefore, it is an unexpected benefit of the Applicant's invention to have a hydroquinone composition at around neutral pH. Gordon would not inherently have neutral compositions (in Applicant's claimed range of about 5.5 to about 8.0), since one of ordinary skill in the art would expect Gordon's composition at Applicant's pH to discolor.

Additionally, the Examiner does not show any teaching or suggestion to combine or modify Gordon with the teachings of Clum. Gordon's invention is concerned with "a treatment for hyperpigmentation that is at least as effective as hydroquinone, but lacks hydroquinone's side effects." (Col. 1, lines, 40-41). One of ordinary skill in the art would not look to Clum, which is concerned with "chemically stable skin care compositions comprising water-in-oil emulsion and certain retinoids," (Col. 1, lines 15-17), to solve a problem with hydroquinone's side effects. Therefore, the Examiner has not met the burden of showing a teaching or suggestion, and the rejection should be removed. Additionally, there is no teaching or suggestion to use Clum with Gordon and one of ordinary skill in the art would not use a reference about stable retinoid water-in-oil emulsions (Clum) when the problem at hand is hydroquinone side-effects (Gordon). Applicant respectfully requests that the rejection be removed.

Provisional Double Patenting Rejection

According to the Examiner, "Claims 77-106 of this application conflict with claims 54-76 of Application No. 10/616,778. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application." The Examiner provisionally



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rejected the pending claims under the doctrine of obviousness-type double patenting. Applicant traverses this provisional rejection for at least the following reasons.

On October 2, 2002, the PTO Examiner in Application No. 09/864,083 issued a restriction requirement, and the currently pending application at issue (No. 10/616,813) is a divisional application required by the PTO. Under MPEP 804.01 "Prohibition of Double Patenting Rejections" and 35 U.S.C. § 121, the use of a patent issuing from an application which was filed as the result of a restriction requirement cannot be used against a divisional application. Therefore, there is a prohibition against this provisional double patenting rejection because both the Application at issue and Application No. 10/616,778 are divisional applications filed as a result of the same restriction requirement in their parent Application No. 09/864,083. Applicant respectfully requests that this rejection be withdrawn.

## CONCLUSION

Applicant respectfully submits that the application is in condition for allowance. Applicant does not believe any additional fee is required for this Response and Request for Reconsideration, however, in the event any additional fee is required or any overpayment credit is due, the Commissioner is hereby authorized to charge Deposit Account No. 18-0586.

I hereby certify that this paper and the papers referred to herein as being transmitted, submitted, or enclosed herewith in connection with U.S. Serial No. 10/616,813 is/are being facsimile transmitted to the United States Patent and Trademark Office fax number 703-872-9306 on the date shown below.

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October 19, 2004
Date of Facsimile Transmission

Respectfully submitted,
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